

REMARKS

Upon entry of this *Amendment And Response*, the present application will contain forty three (43) claims total inclusive of twenty seven claims that were withdrawn previously. More specifically, claims 2 and 16 have been canceled, claims 1, 3, 4, 5, 6, 9, 17 and 18 amended, and claims 7, 8 and 10-15 unchanged, leaving the application with sixteen (16) claims at issue, one (1) of which independent. Counting claims 19-45 that were previously withdrawn, the application contains forty three claims, three (3) of which independent.

Claim 1 stands rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 2002/0151927 to *Douk et al.* Specifically, on pages 2-4 of the Office Action, the Examiner reproduced the language of claim 1 and indicated that paragraphs [17] and [18] of the *Douk et al.* publication were relevant to the issue of novelty.

As shown above, independent claim 1 has been amended herein to include several additional limitations. Consequently, claim 1 and its dependents are now believed to be novel over the *Douk et al.* publication and other references cited in the Office Action.

To assert anticipation under 35 U.S.C. §102, the Court of Appeals for the Federal Circuit has held that an Examiner:

must show that each element of the claim in issue is found, either expressly described or under principles on inherency, in a single prior art reference, or that the claimed invention was previously known or embodied in a single prior art device or practice.

* * *

[I]t is ... necessary that the claims under attack, as construed by the court, 'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it.

Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 224 USPQ 520 (U.S. 1984) (emphasis added).

The Federal Circuit has addressed the test for anticipation even more forthrightly in other cases:

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. (citations omitted)

* * *

In deciding the issue of anticipation, the trier of fact must identify the elements of the claims, determine their meaning in the light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference.

Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al., 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added); Kistler Instrument A.G. v. United States, 628 F.2d 1303, 1311, 203 USPQ 511, 519, aff'd, 211 USPQ 920 (Ct. Cl. 1980) ("The test for determining if a reference anticipates a claim of a patent is whether the reference contains within its four corners adequate directions for the practice of the patent claim....").

In view of the applicable case law, Applicants respectfully submit that the *Douk et al.* publication does not anticipate the invention recited in claim 1 or its dependents. In paragraph (c), claim 1 now includes several limitations related to the structure, positioning and deployment of the sheathless filter. For example, the sheathless filter is now recited as being "*formed of resilient flexible members interlaced to form a tubular net*" between the tubular guidewire and the control cable to which it is coupled proximally and distally, respectively. And it is "*radially expandable in response to displacement of the control cable relative to the tubular guidewire into a plurality of selectively deployable states inclusive of (I) an undeployed state ... and a (II) a fully deployed state....*" In the undeployed state, the "*resilient flexible members lie generally parallel to a longitudinal axis of the control cable and tubular guidewire*" while, in the fully deployed state, the "*resilient flexible members are radially expanded from the longitudinal axis of the control cable and tubular guidewire to a diameter coincident with a diameter of a blood vessel when introduced thereinto....*"

Additionally, claim 1 has also been amended to include the limitations contained in paragraph (d) of the claim. The paragraph contains limitations as to a "*means for resisting displacement of the*

control cable relative to the tubular guidewire.” This means enables the “sheathless filter to be maintained in any of the selectively deployable states so selected” between the undeployed state to the fully deployed state. Moreover, the location of the means relative to other hardware elements of the claim is also specified, specifically the means is situated “approximate the proximal end of the tubular guidewire.” Dependent claims 3 and 4 provide additional structural limitations for this means.

Applicants respectfully submit that the *Douk et al.* publication fails to disclose “each and every element of the claimed invention, arranged as in the claim [1 reviewed above],” as mandated by the Federal Circuit in Lindemann, supra, and required by 35 U.S.C. §102. Specifically, *inter alia*, it does not disclose one or more of the limitations of paragraphs (c) and (d) discussed above. For the foregoing reasons, Applicants believe that this rejection is not applicable to claim 1 as amended or to any of its dependent claims. Applicants respectfully submit that these claims are now allowable over the *Douk et al.* publication.

In view of the above amendments and the foregoing arguments, Applicants believe that the §103(a) rejections of the claim have also been overcome. For these reasons, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. §103(a) rejections of the cited claims.

CONCLUSION


Before entry of this *Amendment And Response*, the present application had claims 1-45 pending, three (3) of which independent. Earlier in prosecution, claims 19-45 were withdrawn inclusive of two independent claims (i.e., claims 19 and 24).

Upon entry of this *Amendment And Response*, the present application will contain forty three (43) claims total, which includes the twenty seven withdrawn claims. More specifically, claims 2 and

16 have been canceled, claims 1, 3, 4, 5, 6, 9, 17 and 18 amended, and claims 7, 8 and 10-15 unchanged, leaving the application with sixteen (16) claims at issue, one (1) of which independent.

Given the foregoing, Applicants respectfully request withdrawal of the rejections set forth in the Office Action dated 19 May 2008. Applicants believe the application is ready to be allowed. If the Examiner has any questions about this *Amendment And Response*, he is invited to call the undersigned at the number listed below.

Respectfully submitted,


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I hereby certify that this correspondence is being electronically filed with the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on 19 November 2008.


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